

Application No. 10/783,810
Response dated November 29, 2006
Reply to Office Action of September 29, 2006

REMARKS

Claims 1-17 are pending in this application. The Examiner contends that this Application contains the following inventions or groups of inventions:

Group I, claims 1-5 drawn to products wherein X is O;

Group II, claims 1 and 2 drawn to products wherein is S;

Group III, claims 6-16 drawn to methods of use of a product wherein X is O;

Group IV, claims 6, 7, and 11-16 drawn to methods of use of product wherein X is S;

and

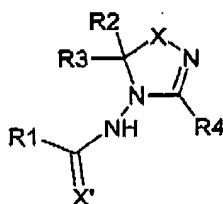
Group V, claim 17 drawn to a process of making a polypeptide.

The Examiner suggested that the inventions listed as Groups I and II are independent or distinct from one another as they differ materially in structure and element. The Examiner suggested that Groups I-II and III-IV are related as product and process. Specifically, the examiner suggests that the Groups comprise a compound, a method of modulating gene expression and a method of polypeptide synthesis and they have different designs and modes of operations.

In reply, and solely to be responsive to the Examiner's requirement, Applicants provisionally elect Group I, claims 1-5, drawn to products wherein X is O. The Examiner has also requested that Applicants make a species elections.

Election of Species

Applicants provisionally elect:



wherein X = O

R¹ = 2-fluoro-4-ethylphenyl;

R², R³ = -(CH₂)₄-; and

R⁴ = 3,5-dimethylphenyl.

This election of species is relevant for claims 1-5.

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Under 35 U.S.C. § 121, restriction may be required if "two or more independent and distinct inventions are claimed in one application." According to the interpretation provided in MPEP § 802.01, the term "independent" means that "there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect...." The term "distinct" is defined in MPEP § 801.02 as meaning that "two or more subjects as disclosed are related... but are capable of separate manufacture, use or sale as claimed, and ARE PATENTABLE (novel and unobvious) OVER EACH OTHER..." (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

The mere existence of two or more independent or distinct inventions in one application is not sufficient to justify a restriction requirement.

According to the guidelines in MPEP § 803, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Further, all of these claims involve a fundamental determination of the novelty of this class of oxadiazolines, and their use in modulating the expression of a target gene via an inducible gene expression system. To the extent that this determination would be made, it is submitted that a preponderantly coextensive search would result. In particular, an exhaustive search for oxadiazoline ligands of the present invention would encompass other oxadiazolines. Performing an entire search covering a gene expression system and oxadiazoline ligands is less burdensome on the Examiner than separate searches, which necessarily involve duplication of searching efforts.

Applicants respectfully submit that prosecution of the claims of Groups I and III designated by the Examiner in the present Application is appropriate. Under Patent Office examining procedures, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it

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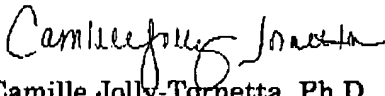
includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added). The groups designated by the Examiner fail to define products with properties so distinct as to warrant separate examination and search. The present claims represent a web of knowledge and continuity of effort that merits examination in a single application.

Thus, Applicants submit that the search and examination of claims 1-17 can be made without serious burden. Applicants respectfully submit that conjoint examination and inclusion of these claims of the present application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction of Groups I and III is believed to be in order.

Conclusion

Applicants respectfully submit that claims 1-17 are related as they are drawn to compounds that can be used with the method to regulate the gene expression system. Further, insufficient reasons have been put forth to support a restriction between the inventions of Groups I and III. In view of the above remarks, Applicants respectfully request reconsideration and withdrawal of the finding of lack of relatedness between the claims of Groups I and III. These claims should fairly be examined in a single application. In the event that the restriction requirement is maintained, Applicants reserve the right to file divisional application(s) directed to the subject matter of the non-elected claims. If a telephone interview would be of assistance in advancing prosecution of this application, Applicants' agent invites the Examiner to contact her at (610) 650-8734 ext. 104.

Respectfully submitted,


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